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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,234	08/22/2001	Max Hineman	150.0045 0122	9323

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EXAMINER

WEBB, GREGORY E

ART UNIT PAPER NUMBER

1751

DATE MAILED: 01/31/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/935,234

Applicant(s)

HINEMAN ET AL.

Examiner

Gregory E. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 64-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 64-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The following action is in response to the amendments mailed 12-16-02.

Claim Rejections - 35 USC § 112

Previous rejections to claim 64-70 are withdrawn based on the applicant's arguments.

Claim Rejections - 35 USC § 102/103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 64-70 remain rejected under 35 USC 102 as being anticipated by Oles.

Claims 64-70 remain rejected under 35 USC 102 as being anticipated by Baker.

Claims 64-70 remain rejected under 35 USC 103 as being unpatentable over Hitachi.

Claims 64-70 remain rejected under 35 USC 103 as being unpatentable over Petzow in view of Hwang et al (US 4,681,657).

Claims 64-70 remain rejected under 35 USC 103 as being unpatentable over Koike in view of Hwang et al (US 4,681,657).

Claims 64-70 remain rejected under 35 USC 103 as being unpatentable over Martin in view of Hwang et al (US 4,681,657).

Claims 64-70 remain rejected under 35 USC 103 as being unpatentable over Koike in view of Hwang et al (US 4,681,657).

Response to Arguments

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Applicant's arguments filed 12-16-02 have been fully considered but they are not persuasive, save the arguments regarding 112 rejections.

The applicant argues the following points: 1) Oles does not exemplify a composition containing phosphoric and acetic acid; 2) the phrase "consisting essentially of" excludes ingredients of the prior art (i.e. Baker, Oles, etc.); 3) Oles fails to teach the functional property of etching rate of their compositions; 4) Hitachi and Hwang et al fail to support a prima facie obviousness rejection because they don't teach the limitations of claim 64; 5) diluting the prior art compositions would not be obvious.

Concerning argument 1, the examiner is not required to be limited to examples. The examiner may rely on the general teaching of the prior art. Thus the examiner has met the burden of anticipation. Furthermore, the applicant has not provided any proof that these additional ingredients would be detrimental. This is the applicant's burden. It is not the burden of the examiner to demonstrate that they would materially affect the composition. The examiner is not equipped to make this argument. The applicant however is perfectly able to perform experiments to demonstrate the detriment of these compounds. Thus the burden rests upon the applicant.

Similarly, concerning argument 2, the term "consisting essentially of" only limits the claims to excluded compounds clearly excluded by the specification. The applicant's proof that these additional compounds would be detrimental rests only on the statement "Such other components would most certainly include those items that may negatively affect semiconductor fabrication." Noting that the applicant statement is not definite. "Most certainly" and "may negatively affect" are not substitute for evidence but are clearly conjecture by the applicant.

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Concerning argument 3, again it is the burden of the applicant to demonstrate that functional language is not supported by the prior art. The examiner maintains these are inherent properties. The examiner is not equipped to verify the functional results. Therefore, the burden again rests on the applicant to demonstrate with proof that the functional language is not supported by the prior art.

Concerning arguments 4 and 5, the examiner maintains that dilution with water is obvious. There is not other step in chemistry more basic than dilution. In fact, the applicant's raw chemicals are at some point diluted during their creation. Furthermore, the compositions are diluted again when the substrate is rinsed. The compositions are most probably diluted again when the spent chemicals are disposed. In fact on page 7 of the specification the applicant refers to the working solutions as "dilute composition." If the working composition is a "dilute composition" there must have been a "concentrated composition" at some point. The examiner points to this teaching to demonstrate that dilution is routine.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory E. Webb whose telephone number is 703-305-4945. The examiner can normally be reached on 9:00-17:30 (m-f).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 703-308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink, appearing to be 'Gregory E. Webb', with a stylized, cursive script.

Gregory E. Webb
Primary Examiner
Art Unit 1751

gw
January 29, 2003